

REMARKS

I. Summary of Office Action

Claims 4, 6-7, 9, 17, and 19 were pending in the Application.

Claims 4, 6-7, 9, 17, and 19 were rejected under 35 U.S.C. § 112, second paragraph in relation to the phrase “Personalized Catalog.”

Claims 4, 6, 6, 17, and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent number 6,651,053 (“Rothschild”) in view of United States Patent number 6,144,848 (“Walsh”) and United States Patent number 6,061,057 (“Knowlton”).

Claim 9 was rejected as being unpatentable over Rothschild in view of Walsh, Knowlton, and United States Patent number 5,77,674 (“Veeneman”).

II. Summary of Applicant’s Response

Applicant has canceled claims 4, 6-7, 17, and 19 without prejudice.

The cancellation of the claims does not constitute an acquiescence to the Examiner’s rejections. Applicant reserves the right to further prosecute the same or similar claims in the present or a subsequent application.

Applicant has added new claims 20-34.

Applicant provides a summary of the interview of March 10, 2008.

Applicant traverses the Examiner’s rejections of the claims and requests reconsideration of the application.

III. Interview Summary

On March 10, 2008, the undersigned conducted a telephonic interview with the Examiner to discuss proposed claim 20. Applicant thanks the Examiner for his courtesy in taking the time to conduct this telephonic interview.

IV. The Rejection of the claims Under 35 U.S.C. § 112, second paragraph

The Examiner rejected claims 4, 6-7, 9, 17, and 19 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject

matter which the applicant regards as the invention because “one of ordinary skill in the art would not have the ability to ascertain the meaning and scope of the term ‘Personalized Catalog’.” (Office Action, page 3). After canceling claims 4, 6-7, 17, and 19, no instances of the phrase “Personalized Catalog” are present in the claims. As such, Applicant respectfully submits that the rejection is moot and requests withdrawal of the same.

V. The Rejections of the Claims Under 35 U.S.C. § 103(a) and New Claim 20

Rothschild describes a system for obtaining information related to a barcode. Walsh describes a system that searches one or more memory databases of available goods and/or services to determine whether a substitute item is available. Knowlton describes a system where representations of goods or services can be dragged and dropped into a shopping cart for later purchase.

However, Applicant submits that no combination of Rothschild, Walsh, and/or Knowlton teaches or suggests the combination of elements recited in claim 20. Claim 20 recites a method for managing scan-based input including:

- (a) receiving a plurality of barcodes at a server from a customer;
- (b) resolving each of the plurality of barcodes into a corresponding plurality of product identifiers, said plurality of product identifiers stored in a product database in communication with said server;
- (c) creating a catalog including the plurality of barcodes and a corresponding plurality of product descriptions arranged such that each barcode of the plurality of barcodes is located in proximity of a product description of the plurality of product descriptions which it identifies;
- (d) sending the catalog to the customer;
- (e) receiving a selection of a first product in response to a barcode of said plurality of barcodes in the catalog being scanned by the customer;
- (f) determining whether said first product is available by querying said product database;
- (g) if it is determined that said first product is not available by querying said product database, determining whether a substitute product is indicated in a substitute table;
- (h) if said first product is determined not to have a substitute indicated in the substitute table, searching for at least one product substitute in the product database by comparing attributes of the first product to attributes of products in the product database;

(i) if at least one product substitute is found in the product database, adding the at least one product substitute to the substitute table and sending the customer a recommendation of the at least one product substitute;

(j) receiving approval from the customer in response to the recommendation of a product substitute; and

(k) in response to the approval, saving the approved substitute product in a shopping cart of the customer.

For example, neither Walsh alone, nor Walsh in combination with Rothschild and/or Knowlton, teaches or suggests at least:

(f) determining whether said first product is available by querying said product database;

(g) if it is determined that said first product is not available by querying said product database, determining whether a substitute product is indicated in a substitute table;

(h) if said first product is determined not to have a substitute indicated in the substitute table, searching for at least one product substitute in the product database by comparing attributes of the first product to attributes of products in the product database; and

(i) if at least one product substitute is found in the product database, adding the at least one product substitute to the substitute table and sending the customer a recommendation of the at least one product substitute.

Instead, Walsh merely describes “search[ing] one or more memory databases of available goods and/or services to determine whether a substitute item is available” and if so, “replac[ing] the original UPC-identified product with the substitute product.” (Walsh, column 37, lines 21-53). Walsh does not, for example, teach or suggest searching a product database for a substitute contingent on a substitute not being present in a substitute table. Nor does Walsh teach or suggest, adding the substitute product to the substitute table upon finding the substitute product in the product database. No combination of Walsh with Rothschild and/or Knowlton remedies these inadequacies.

Accordingly, Applicant respectfully submits that claim 20 is allowable.

VI. New Claims 21-34

Each of independent claim 25 and claim 30 recite analogous elements to independent claim 20 and is therefore allowable for at least the reasons provided with respect to claim 20.

Claims 21-24, 26-29, and 31-34 each depend from one of claims 20, 25, and 30 and are thus allowable for at least the same reasons as the claim from which they depend. Accordingly, Applicant submits that claims 21-24, 26-29, and 31-34 are also allowable.

CONCLUSION

Applicant respectfully submits that, as described above, the cited reference does not show or suggest the combination of features recited in the claims. Applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples Applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicant asserts that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicant has emphasized certain features in the claims as clearly not present in the cited reference, as discussed above. However, Applicant does not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicant has provided examples of why the claims are distinguishable over the cited prior art.

Any amendments made to the claims in the present Reply are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather, these amendments are merely Applicant's attempt at providing one or more definitions of what the Applicant believes to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicant is seeking for this application. Therefore, no estoppel should be presumed, and Applicant's claims are intended to include a scope of protection under the Doctrine of Equivalents.

For at least the reasons set forth above, Applicant respectfully submit that this application is in condition for allowance. Reconsideration and prompt allowance of the application are respectfully requested.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment, to Deposit Account No. 08-0219

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 08-0219.

Respectfully submitted,
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